



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,050	10/30/2000	William J. Flanagan	ET00-005CIP	8548

7590

09/09/2005

Maureen Stretch
26 Charles Street
Natick, MA 01760

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/702,050

Applicant(s)

FLANAGAN ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-89 is/are pending in the application.
- 4a) Of the above claim(s) 10-29 and 38-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2005 has been entered.

The claims are referred to as numbered prior to allowance and include the previous corrections under Rule 1.126.

In response to the Restriction requirement, Applicant has elected Species I (claims 2-9 and 30-37).

Claims 2-9 and 30-37 are presented for examination.

Priority

2. This application was filed on October 30, 2000 as a continuation-in-part of various applications filed on November 16, 1998. It has been determined that some of the pending claims contain continuation-in-part subject matter (i.e., subject matter that was not disclosed in the parent applications). For example, the recited "dynamic contracts manager" (recited in claims 5, 9, 33, and 37) is not disclosed in the parent

Art Unit: 3623

applications. Therefore, claims 5, 9, 33, and 37 are granted a priority date of October 30, 2000 for purposes of applying prior art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5, 9, 33, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by INSS, as disclosed in the packet of information cited by Applicant as "INSS Negotiation Protocol" (dated September 1, 1998, listed on page 3 of the IDS stamped as received on February 18, 2005).

Claims 2-4, 6-8, 30-32, and 34-36 are rejected under 35 U.S.C. 102(a) as being anticipated by INSS, as disclosed in the packet of information cited by Applicant as "INSS Negotiation Protocol" (dated September 1, 1998, listed on page 3 of the IDS stamped as received on February 18, 2005).

INSS discloses an apparatus for communicating information about a negotiation, comprising:

[Claim 2] a multivariate negotiations system including storage space and negotiations software (Page 1 -- "INSS is a Web-based negotiation support system"; Pages 10-11, 15 -- A history of offers and messages may be accessed; therefore, offer

Art Unit: 3623

and message information must be stored, esp. since it is used to generate a graph of the respective histories), such negotiations software executing in a processor and including an automated negotiations engine for analyzing terms, the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose, and placing them into user supplied context for use by a user (Pages 2, 8-13 -- The fact that the offer history data is maintained, graphed, and used by the negotiation software to determine if an optimal agreement has been reached or suggest a Pareto-optimal agreement for both parties is indicative of the fact that INSS itself analyzes and understands the negotiation terms), the automated negotiations engine being responsive to a destination terminal for a first user communicating with the multivariate negotiations system, the destination terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, the automated negotiations engine also being responsive to an initiating terminal for a second user communicating with the multivariate negotiations system, the initiating terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, during iterative processing the automated negotiations engine recognizing the users at the destination terminal and the initiating terminal as negotiators and recognizing one of the users as a deciding entity (Pages 1, 6, 17 -- Registered users may participate in web-based negotiations using INSS. Even though each party can send various offers before receiving a response from the respective counterparty, INSS recognizes which party is officially waiting for a response, thereby recognizing a relative "deciding entity." See

Art Unit: 3623

page 17, item 5 in particular), such automated negotiations engine further recognizing any changes in the terms and storing in the storage space the terms each terminal proposes, and recognizing the terminal to which proposal terms are being sent as the indicated terminal, and sending terms to the indicated terminal, the automated negotiations engine indicating any changes in the terms until a set of terms is acted upon in a final manner by the deciding entity (Pages 1-2, 8-13, 16, 17 -- The storage space, analysis of terms and changes thereof, and recognition of a terminal are addressed above);

a contract authority for assigning a unique identifier to such a negotiation at the initiation of negotiations (Page 6 – A negotiation name is assigned);

[Claim 3] wherein the contract authority further comprises a contracts router for routing negotiation information related to a unique identifier (Pages 6-13, 17 – INSS automatically routes negotiations messages to the parties involved in a particular negotiation. INSS keeps track of which party's turn it is to respond during each stage of a negotiation);

[Claim 4] wherein the contract authority further comprises a central contracts switch for forwarding information from the contracts router to a designated recipient (Pages 6-13, 17 – INSS automatically routes negotiations messages to the parties involved in a particular negotiation. INSS keeps track of which party's turn it is to respond during each stage of a negotiation);

[Claim 5] wherein the contract authority further comprises a dynamic contract manager for querying a contract router for information about an identified negotiation

(Pages 6-13, 17 – INSS automatically routes negotiations messages to the parties involved in a particular negotiation. INSS keeps track of which party's turn it is to respond during each stage of a negotiation).

[Claims 6-9] Claims 6-9 recite limitations already addressed by the rejection of claims 2-5 above; therefore, the same rejection applies.

INSS discloses an apparatus for communicating information about automatically processing at least one negotiation between first and second users who are communicating over a network to each other negotiation terms that include a plurality of variables, comprising:

[Claim 30] a contract authority for assigning a unique identifier to such a negotiation (Page 6 – A negotiation name is assigned); and

negotiating software executing in a processor and configured for processing such a negotiation by (Pages 2, 8-13 -- The fact that the offer history data is maintained, graphed, and used by the negotiation software to determine if an optimal agreement has been reached or suggest a Pareto-optimal agreement for both parties is indicative of the fact that INSS itself analyzes and understands the negotiation terms):

- responding to and recognizing the first and second users as negotiators,
- designating one of the users as a deciding entity;
- receiving a negotiation term from one of the users;
- analyzing the negotiation term to understand its purpose;

formatting the negotiation term according to the understood purpose;
placing the formatted negotiation term into a context supplied by at least one of the users;
indicating a detected change in a negotiation term to at least one of the users;
sending the negotiation term to one of the users;
storing the negotiation term; and
repeating the above processing until a signal is received from the deciding entity to stop negotiations (Page 1 -- "INSS is a Web-based negotiation support system"; Pages 10-11, 15 -- A history of offers and messages may be accessed; therefore, offer and message information must be stored, esp. since it is used to generate a graph of the respective histories; Pages 2, 8-13 -- The fact that the offer history data is maintained, graphed, and used by the negotiation software to determine if an optimal agreement has been reached or suggest a Pareto-optimal agreement for both parties is indicative of the fact that INSS itself analyzes and understands the negotiation terms; Pages 1, 6, 17 -- Registered users may participate in web-based negotiations using INSS. Even though each party can send various offers before receiving a response from the respective counterparty, INSS recognizes which party is officially waiting for a response, thereby recognizing a relative "deciding entity." See page 17, item 5 in particular);
[Claim 31] wherein the contract authority further comprises a contract router for routing negotiation information related to a unique identifier (Pages 6-13, 17 -- INSS

Art Unit: 3623

automatically routes negotiations messages to the parties involved in a particular negotiation. INSS keeps track of which party's turn it is to respond during each stage of a negotiation);

[Claim 32] wherein the contract authority further comprises a central contract switch for forwarding information from the contract router to a designated recipient (Pages 6-13, 17 – INSS automatically routes negotiations messages to the parties involved in a particular negotiation. INSS keeps track of which party's turn it is to respond during each stage of a negotiation);

[Claim 33] wherein the contract authority further comprises a dynamic contract manager for querying a contract router for information about an identified negotiation (Pages 6-13, 17 – INSS automatically routes negotiations messages to the parties involved in a particular negotiation. INSS keeps track of which party's turn it is to respond during each stage of a negotiation).

[Claims 34-37] Claims 34-37 recite limitations already addressed by the rejection of claims 30-33 above; therefore, the same rejection applies.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

September 6, 2005